



DOCKET NO.: 8527-002

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Ronald J. MacNeil

Part of Paperfile

Application No.: 09/030,702

Group No.: 3711

Filed: February 25, 1998

Examiner: Not Assigned

For: Lacrosse Stick Head

BOX DAC
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

**REVISED AND RENEWED PETITION UNDER 37 C.F.R. § 1.47(b) AND
RESPONSE TO DECISION IN REFUSING STATUS UNDER 37 C.F.R. §1.47(b)**

Applicant hereby renews its Petition to the Assistant Commissioner pursuant to 37 C.F.R. § 1.47(b) to accept the above-identified patent application without the signature of the inventor. The averments of the initial Petition are incorporated herein by reference. Pursuant to 37 C.F.R. §1.47(b), this paper is submitted in response to the DECISION REFUSING STATUS UNDER 37 CFR 1.47(b) dated April 13, 1998.

The Applicant hereby includes the information requested as follows: (1) Letter from Applicant's attorney dated May 11, 1998 transmitting the Reissue Application and requesting execution of the Reissue Declaration; (2) Letter addressed to Applicant's Attorney from the inventor dated May 18, 1998, refusing to execute the Revised Declaration; (3) A Renewed Declaration executed under §1.47(b) setting forth the pertinent facts showing that this action is necessary to prevent irreparable harm; (4) the required \$130.00 fee under 37 C.F.R. §1.47(b) and 1.17(h); (5) proof of proprietary

09/030,702
00000025 500204
10/20/1998 REFILED 00000025 500204
02 FC:122 130.00 CH

interest, and (6) Verified Statement Claiming Small Entity Status.

Favorable consideration and an early grant of this Petition is respectfully requested.

Respectfully submitted,

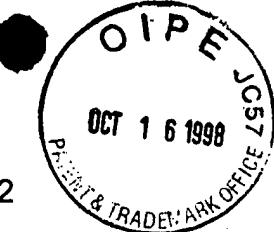


Scott J. Fields
Registration No. 32,857

Date: October 13, 1998

KLEHR, HARRISON, HARVEY,
BRANZBURG & ELLERS
1401 Walnut Street
Philadelphia, PA 19102-3163
(215)569-6060

DOCKET NO.: 8527-002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Ronald MacNeil

Application No.: 09/030/702

Filed February 25, 1998

For: Lacrosse Stick Head

BOX DAC
Assistant Commissioner of Patents
Washington, DC 20231

Sir:

**REVISED AND AMPLIFIED DECLARATION
PURSUANT TO 37 C.F.R. § 1.47(b)**

As Principal of the assignee, Shamrock Lacrosse, Inc., I hereby declare that:

1. I am authorized to act on behalf of Shamrock Lacrosse, Inc., Assignee of US Patent No. 5,494,297, of which my title is President and I am executing this Declaration in response to the Decision Refusing Rule 47 status and in furtherance of my original Declaration under 37 C.F.R. §1.47(*b) which is incorporated herein by reference.
2. The entire title to the patent application identified below is assigned to Assignee, Shamrock Lacrosse, Inc. The Inventor's assignment has been recorded in the U.S. Patent & Trademark Office at Reel & Frame: 7961/0966, a copy of which is attached.
3. I verify that the named Applicant, Ronald J. MacNeil, is the original, first and sole inventor of the subject matter which is claimed and for which a Reissue Patent is sought on the invention entitled: LACROSSE STICK HEAD the specification of which was filed on February 25, 1998 as Application Serial No. 09/030,702.
4. I hereby state that the named inventor, Ronald J. MacNeil, has refused to sign the application for patent, and therefore, under 37 CFR §1.47(b), as the representative of Assignee of the above named patent application, I am authorized to act as legal representative in the prosecution of said application and to execute this Declaration.
5. I hereby state that on May 11, 1998, our attorneys contacted Ronald J. MacNeil of Milton, Ontario, Canada, the inventor of the above referenced patent application

Part of Paper #6
Group No.: 3711
Examiner: Not Assigned

RECEIVED
OCT 21 1998
OFFICE OF PETITIONS
DEPUTY A/C PATENTS

and requested that Mr. MacNeil execute the Reissue Application. A copy of Counsel's letter transmitting the application and declaration is attached hereto as Exhibit A. By letter dated May 18, 1998, Mr. MacNeil stated his refusal to sign. This letter is also attached hereto as Exhibit B.

6. I hereby state the Ronald J. MacNeil had assigned outright his invention to Shamrock Lacrosse, Inc., including all rights to any reissue patents. Our agreement called for Mr. MacNeil's assistance in securing such rights. Mr. MacNeil refused to assist us unless our company agreed to provide him with additional compensation. Our agreement required no such additional compensation.

7. I hereby state that Mr. MacNeil contacted us and made unsubstantiated statements to the effect that the claim coverage which we are seeking in the attached reissue application does not distinguish over the prior art. Mr. MacNeil was requested by our attorneys to provide documentation and evidence in support of these allegations, including the allegations in his letter of May 18, 1998, but he failed to do so. We concluded, therefore, that Mr. MacNeil had no such knowledge and only sought to frustrate and obstruct our lawful rights to obtain a reissue patent.

9. We are filing the application without Mr. MacNeil's signature in order to preserve the rights of our company and to avoid irreparable harm.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: Oct 7, 1998

Peter W. Rogers
Peter W. Rogers, President
Shamrock Lacrosse, Inc.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JANUARY 14, 1997

PTAS



100325303A

SHAMROCK LACROSSE
PETER W. ROGERS
P.O. BOX 367
96 PARK AVE.
SUMMIT, NJ 07901

CORRECTED
NOTICE

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/03/1996

REEL/FRAME: 7961/0966
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNEE'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
MACNEIL, SANDRA LYNN

DOC DATE: 04/11/1996

ASSIGNEE:
SHAMROCK LACROSSE INC.
96 PARK AVENUE
P.O. BOX 367
SUMMIT, NEW JERSEY 07901

SERIAL NUMBER: 08285125
PATENT NUMBER: 5494297

FILING DATE: 08/02/1994
ISSUE DATE: 02/27/1996

LENELL MACKALL, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Exhibit A

KLEHR, HARRISON, HARVEY, BRANZBURG & ELLERS LLP

MORTON R. BRANZBURG*
DONALD M. HARRISON*
LAWRENCE J. AREM
ROSETTA B. PACKER
RICHARD S. ROISMAN
GARY W. LEVI*
MICHAEL C. FORMAN*
MICHAEL K. CORAN
FRANCIS M. CORRELL, JR.
KEITH W. KAPLAN**
DOUGLAS F. SCHLEICHER*
ROBERT W. CLEVELAND*
BARRY J. SIEGEL
JEFFREY M. NAVON*
MICHAEL L. CORDONE
GARY A. DEUTSCH*
BRADLEY A. KROUSE*

WILLIAM A. HARVEY
LEONARD M. KLEHR
RONA J. ROSEN*
STEPHEN T. BURDUMY*
CAROL ANN SLOCUM*
ARNOLD E. COHEN
JEFFREY KURTZMAN**
JILL E. JACHERA*
MARC R. GARBER
PAUL G. NOFER
RICHARD A. LEVAN***
JOANNE B. WILLS*
SCOTT J. FIELDS*
RICHARD M. BECK*
DENISE M. DAY*
DAVID S. EAGLE**
BENJAMIN J. BERGER*

ATTORNEYS AT LAW
1401 WALNUT STREET
PHILADELPHIA, PENNSYLVANIA 19102-3163

(215) 568-6060
FAX: (215) 568-6603

NEW JERSEY OFFICE
457 HADDONFIELD ROAD
SUITE 510
CHERRY HILL, NEW JERSEY 08002-2220
(609) 486-7900

DELAWARE OFFICE
919 MARKET STREET
SUITE 1000
WILMINGTON, DELAWARE 19801-3062
(302) 426-1189

SALLY P. SCHREIBER
EMILY M. CLAY*
STEVEN A. KAYE***
MINDY FRIEDMAN*
GERALD F. STAHLCKER III*
FREDRIC J. KINKLER, JR.*
SHAHAN G. TEBERIAN*
SHARI AMSTER*
MICHAEL CONFUSIONE**
BRIAN T. FLYNN*
MICHAEL A. LA CONELLI*
MICHAEL R. NESTOR**
IRA A. ROSENNAU*
ANDREW L. ZIVITZ*
CRAIG P. ZAPPETTI*
HUGH W.P. FISHER*
ANTHONY P. TABASSO*

DAVID ZALESNIE
JOSEPH G. GIBBONS*
GARY L. LOZOFSKY*
PETER J. NORMAN*
CYNTHIA A. CLARK
WILLIAM W. MATTHEWS III*
GLENN A. WEINER*
CYNTHIA Y. WONG***
STEPHEN C. EGLEN
JEFFREY P. FOXTER*
HEATHER I. LEVINE*
DANIEL P. O'BRIEN**
BRIAN I. SOPINSKY*
MATTHEW J. EISENBERG*
CHRISTOPHER S. CONNER
LEE D. MOYLAN*

COUNSEL TO THE FIRM
GERALD BROKER

May 11, 1998

Direct Dial: (215)569-2699

400-50084112

Via Federal Express

Mr. Ronald J. MacNeil
843 Coulson Avenue
Milton, Ontario L9T 4K3
Canada

RE: Reissue Patent Application Serial No. 09/030,702
Our File No. 8527-001

Dear Mr. MacNeil:

Per the request of the Patent and Trademark Office, enclosed please find a copy of the reissue application and declaration in the above captioned matter. Please review the application and the amended claims.

Please then execute the reissue declaration at the point noted and return to us in the self-addressed, stamped envelope.

If you do not have the signed document back in our hands by Friday, June 5, 1998, we will assume that you do not intend to execute the document and we will proceed accordingly.

KLEHR, HARRISON, HARVEY, BRANZBURG & ELLERS LLP

Mr. Ronald J. MacNeil

May 11, 1998

Page 2

Please do not hesitate to contact me should you wish to discuss this matter further.

Very truly yours,



Scott J. Fields

SJF/gdb

JUN. 1. 1998 9:12AM

PAUL D. STUNT BARRISTERS

NO. 681

P. 1/2

Exhibit B

FAX COVER SHEET

TO: Mr. Scott J. Fields
Klehr, Harrison, Harvey, Branzberg & Ellers
Philadelphia, PA

FAX NO. (215) 568-6603

FROM: Ronald J. MacNeil

DATE: June 1, 1998

Fay

KLEHR, HARRISON, HARVEY BRANZBURG & ELLERS
ATTORNEYS AT LAW
1401 WALNUT STREET
PHILADELPHIA, PENNSYLVANIA
19102-3163
1-215-568-6060
FAX 215-568-6603

Ron MacNeil
843 Coulson Ave.
Milton, Ontario
Canada, L9T 4K3

May 18/98

MR. SCOTT J. FIELDS

RE: Your letters of Feb/98 and May/98 concerning the changing and adding of claims to patent No. 5,494,297 Reissue application number 09/030,702 and Docket no. 8527-002.

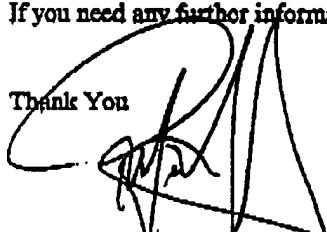
As per our phone discussion of Feb/98. At that time you felt that I had not claimed the so called offset lacrosse stick head. My response to you was that most of the wooden sticks in Canada have been made offset for the last 100 years and this is the proper way to make a lax stick. This is why I did not claim the offset, it is prior art being used throughout the world for the last 100 + years. As far as your claim (on page 10, line 8 & 9) this is what a so called offset head is, the mouth is always the lowest part of the stick, i.e. A skimmer bird (this claim is prior art, there is no question about it.).

There is a great misconception on lacrosse sticks, there are two games of lacrosse played throughout the world Field Lacrosse and Box Lacrosse. Up to the late 1970's and early 80's most of the sticks were made of Hickory wood. One designed for field and the other designed for Box lacrosse. All of the Box lacrosse sticks had what people now called offset (to us in Canada it was a normal stick). In 1966 I designed the first fiberglass lacrosse stick with all the features of the wooden Box Lacrosse Stick. In 1992 I designed a Plastic Lacrosse stick again for Box Lacrosse (as per drawings in Patent 5,494,297). As you know I have a patent for the duel side walls. I did not apply for a patent for what is called offset & or the mouth below the shaft, again the reason prior Art.

If you want to see one of these sticks you can go to the Lacrosse Hall of Fame in British Columbia, Canada, or just come to Canada and watch a Box game where wooden sticks are being used. The simpler way of seeing these sticks is to come to my Lacrosse Shop in Milton, Ontario and I will show you these sticks.

The thing that is happening today in the Lacrosse World is; the Field Lacrosse player likes the Box Lacrosse Stick. The Manufacturers in the USA are changing their designs to meet these needs and when they change their designs they patent them not knowing of the prior art in Canada. Box Lacrosse has been played through out the World and the USA since 1968 (Detroit) and possibly sooner.

I hope this answers any of your questions of why I did not patent the offset head as you suggested. If you need any further information please contact me and arrangements can be made.


Thank You

Ronald J. MacNeil
c/o Commissioner For Patents

DOCKET NO.: 8527-002



PATENT

APPLICANT OR PATENTEE: Reissue Application of Ronald J. MacNeil

SERIAL OR PATENT NO.: 09/030/702

DATE FILED OR ISSUED: February 25, 1998

FOR: LACROSSE STICK HEAD

*RECEIVED
Part of file 2/1 1998
OFFICE OF PETITIONS
DEPUTY AIC PATENTS*

**VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY STATUS
(37 CFR 1.9(f) and 1.27(c)) - SMALL BUSINESS CONCERN**

I hereby declare that I am:

- the owner of the small business concern identified below;
- an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF CONCERN: Shamrock Lacrosse, Inc.

ADDRESS OF CONCERN: P.O. Box 367, Summit, New Jersey 07902

I hereby declare that the above-identified small business concern qualifies as a small business concern as defined in 13 CFR 121.3-18, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either directly or indirectly, one concern controls or has the power to control the other, or a third-party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention, entitled Lacrosse Stick Head

by inventor(s) Ronald J. MacNeil

described in

[] the specification filed herewith.

[XX application serial no. 09/030,702, filed February 25, 1998

[] patent no. _____, issued _____.

If the rights held by the above-identified small business concern are not exclusive, each individual, concern or organization having rights in the invention is listed below* and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

*NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27).

NAME: _____

ADDRESS: _____

[] Individual [] Small Business [] Nonprofit Organization
Concern

NAME: _____

ADDRESS: _____

[] Individual [] Small Business [] Nonprofit Organization
Concern

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small business entity is no longer appropriate. (37 CFR 1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are

DOCKET NO.: 8527-002

PATENT

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING: Peter Rogers

TITLE OR PERSON OTHER THAN OWNER: President

ADDRESS OF PERSON SIGNING: Shamrock Lacrosse, Inc. P.O. Box 367
Summit, New Jersey 07902

SIGNATURE

Peter Rogers

Date: Oct. 7, 1998